

## **Remarks**

The above Amendments and these Remarks are in reply to the Office Action mailed May 30, 2006.

Claims 1-16 were pending in the Application prior to the outstanding Office Action. Claims 1-11 are cancelled. In the Office Action, the Examiner rejected claims 12-16. Reconsideration of the rejections is requested.

### **I. ELECTION/RESTRICTIONS**

In the Office Action, the Examiner writes that "Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to retrieving the critical data from the FLASH memory, classified in class 711, subclass 103.

II. Claims 9-11, drawn to detecting if any of plurality of FLASH ports is connected to a FLASH integrated circuit, classified in class 711, subclass 149.

III. Claims 12-16, drawn to detecting a low power state then storing the critical data in a FLASH memory, classified in class 711, subclass 105.

...

Applicant's election without traverse of claims 12-16 over the telephone restriction practice is acknowledged. Applicant's election was given in a telephone interview with Paul Durdik (Reg. #: 37,819) on May 12, 2006.

Claims 1-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim." See OA, page 2-3.

The present Reply A confirms Applicant's election of Examiner's defined invention III, and the withdrawal of claims 1-11. Further, Applicant requests cancellation of claims 1-11. Applicant reserves the right to represent these claims by filing a divisional application directed thereto.

### **II. OBJECTION TO THE SPECIFICATION**

The Examiner objected to the Specification for the following reason: the cross reference to related application is missing U.S. Patent Application Numbers. This Reply A amends the Specification to cure this defect, and therefore Applicant requests that the objection be removed.

### **III. DOUBLE PATENTING**

In the Office Action, the Examiner writes that "Claims 12-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-10 of copending Application No. 10/727,773."

The Examiner notes that “A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.” A terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) is submitted herewith.

#### **IV. REJECTION UNDER 35 U.S.C. §102(B) OVER *WATTS* (US PAT. 6,336,161 B1)**

##### ***Claims 12-16***

The Examiner rejected claims 12-16 under 35 U.S.C. §102(b) as being anticipated by *Watts*. Applicant respectfully traverses the rejection.

In the Office Action, the Examiner writes that regarding claim 12 “*Watts* teaches a method for storing critical data on a hard drive, comprising: detecting a low power state event (Fig. 2a, step 42; column 4, lines 9-13); retrieving a critical data from the DRAM (Fig. 5; column 5, lines 38-44; column 6, lines 6-13); storing the critical data in a FLASH memory on the hard drive (Fig. 2a, step 44; column 2, line 33-36; column 4, lines 13-19); and powering down the DRAM (Fig. 2a, step 48; column 4, lines 24-25).” See OA, page 5, item 1. However, *Watt* fails to disclose “storing the critical data in a FLASH memory **on the hard drive**” as recited in claim 12. *Watts* describes “once power-down mode begins (block 44), hardware configuration information, which would normally be supplied by the drivers upon start up, is stored in the flash EEPROM.” See col. 4, lines 13-16. Referring to Figure 1 of *Watts*, the flash EEPROM described by *Watt* is **external** to the hard disk drive (“A CPU...is coupled to a semiconductor memory subsystem 13 (including a main memory 14, a Level 2 (L2) cache memory 16, a BIOS (or similar program) memory 18...in many convention computers, the BIOS is stored in a flash EEPROM...” See col. 3, lines 28-31, 52-53).

*Watts* describes multiple embodiments contemplating use of flash memory **external** to the hard disk drive. The claims themselves distinguish between memory of a hard disk drive, and memory external to the hard disk drive, and the specification and claims teach away from the claims of the present invention by making this distinction (e.g., “a hard drive and one or more other devices...said devices having internal memories for storing configuration data...a flash memory...configuration data from said internal memories being stored in said flash memory...” See claim 1, “storing configuration data from internal memories of one or more system devices into a flash memory” See claim 16).

Because *Watts* fails to disclose “storing the critical data in a FLASH memory on the hard drive” as recited in claim 12, *Watts* cannot anticipate claim 12 under 35 U.S.C. §102(b). Dependent claims have at least the features of the claims from which they depend. Claims 13-16 depend from claim 12, therefore *Watts* cannot anticipate claims 13-16 under 35 U.S.C. §102(b).


**V. CONCLUSION**

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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